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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/572,804	08/24/2006	Jerzy A. Bajgrowicz	GIV.P30090	9552	
23575	7590	07/25/2008	EXAMINER		
CURATOLO SIDOTI CO., LPA		ASDJODI, MOHAMMAD REZA			
24500 CENTER RIDGE ROAD, SUITE 280		ART UNIT		PAPER NUMBER	
CLEVELAND, OH 44145		1796			
		MAIL DATE		DELIVERY MODE	
		07/25/2008		PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/572,804	BAJGROWICZ, JERZY A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MOHAMMAD R. ASDJODI	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 August 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/26/06, 05/19/06, 03/22/06</u> .                            | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112 and § 101***

*The following is a quotation of the second paragraph of 35 U.S.C. 112:*

***The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***

35 U.S.C. 101 reads as follows:

***Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.***

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-7 provides for method of using a compound as a fragrance, and it is unclear what method/process applicant is intending to encompass.

It is also noted that claims 6 and 7 have been interpreted as a process claim, since the term “application” appears to convey such meaning.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 8 states “incorporating a compound of formula Ia”: without mentioning into what substance it is mixed. Therefore this renders the claim indefinite.

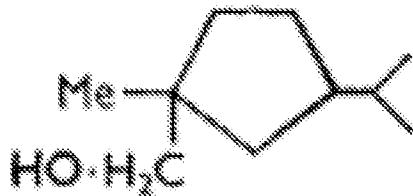
***Claim Rejections - 35 USC § 102***

*The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

***A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or  
in public use or on sale in this country, more than one year prior to the date of application for  
patent in the United States.***

Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Allan et al. (University of Glasgow, UK, Journal of Chemical Society (1959), 2186-92.

Regarding claims 8-10, Allan et al. teach a method of preparing 1-methyl-3-isopropyl cyclopentyl wherein  $R^1 = R^2 = H$ , and  $R^3 = OH$ , as shown in structure below.



With respect to composition's fragrance application, for claims 9, and 10, it has been held that a recitation with respect to the manner in which a claimed article, or composition, is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987), [MPEP 2114, R-1].

***Rejections - 35 USC § 103***

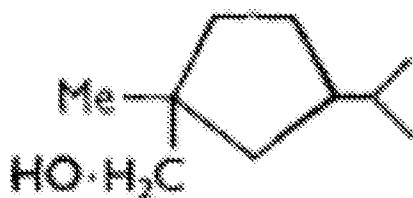
*The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allan et al. (University of Glasgow, UK, Journal of Chemical Society (1959), 2186-92.

Regarding claims 1-7, Allan et al. teach a method of preparing 1-methyl-3-isopropyl cyclopentyl wherein  $R^1 = R^2 = H$ , and  $R^3 = OH$ , as shown in structure below.



Regarding claims 1-7, Allen et al. do not teach its fragrance application. However, Habib-Emil Eschinazi teach a homolog structure of 1-methyl-3-isopropyl cyclopentyl having desirable olfactory characteristics and is used as fragrance in soaps; [2: 18-28, 4: 41]. Habib-Emil and Allan are analogous art, that of chemical structure synthesis methyl-isopropyl cyclopentyls. At the time of invention it would have been obvious to a person of ordinary skill in the art to utilize Habib-Emil 's application for Allan's 1-methyl-3-isopropyl cyclopentyl product with the motivation of making a fragrance.

***Relevant art cited***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO form 892.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. M. Reza Asdjodi whose telephone number is (571)270-3295. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARK EASHOO, Ph.D./  
Supervisory Patent Examiner, Art Unit 1796  
21-Jul-08

/M. R. A./  
Examiner, Art Unit 1796  
07/15/08